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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79171734
Applicant	Lidl Stiftung & Co. KG
Applied for Mark	CHEF SELECT TO GO
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Submission	Appeal to CAFC
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Date	04/19/2019

**IN THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

*In re Lidl Stiftung & Co. KG*

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LIDL STIFTUNG & CO. KG

Appellant,

v.

DIRECTOR, UNITED STATES PATENT AND  
TRADEMARK OFFICE, in his official capacity  
("Director").

Appellee.

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)  
) **NOTICE OF APPEAL**

)  
) Serial No. 79171734

Notice is hereby given that Applicant, Lidl Stiftung & Co. KG, hereby appeals to the United States Court of Appeals for the Federal Circuit from the Opinion rendered by the Trademark Trial and Appeal Board, ("TTAB"), which refused registration of Applicant's mark by the United States Patent and Trademark Office. Applicant-Appellant seeks a review of the TTAB's opinion (no. 79171734 issued February 20, 2019) in its entirety, which held that Applicant's mark was properly refused pursuant to § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). (*See* a true and correct copy of the TTAB Opinion attached hereto as Exhibit 1). The TTAB opinion was received by Applicant-Appellant by email service on February 20, 2019.

Respectfully submitted, this the 19th day of April, 2019.

LOCKE LORD LLP

By: /s/ Scott D. Greenberg

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### **CERTIFICATE OF SERVICE**

I hereby certify that on April 19, 2019, I served the original of this Notice of Appeal (with Exhibit 1) to the Director of the United States Patent & Trademark Office by USPS Priority Express Mail pursuant to 37 CFR §§ 104.2 & 2.198, addressed to Office of the General Counsel, United States Patent and Trademark Office, Post Office Box 1450, Alexandria, Virginia 22313-1450, with Priority Express Mailing Label No. EL 788185456 US.

I hereby also certify that on April 19, 2019, I filed a copy of this Notice of Appeal (with Exhibit 1) with the TTAB by electronic filing through the ESTTA.

I hereby also certify that on April 19, 2019, I filed a copy of this Notice of Appeal (with Exhibit 1) with the Court of Appeals for the Federal Circuit, using the CM/ECF System pursuant to Fed. Cir. R. 25(b)(1).

/s/ Scott D. Greenberg  
Scott D. Greenberg

## Exhibit 1

This Opinion is not a  
Precedent of the TTAB

Mailed: February 20, 2019

### UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Lidl Stiftung & Co. KG*

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Serial No. 79171734

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Scott Greenberg of Locke Lord LLP,  
for Lidl Stiftung & Co. KG.

Keyla Gandara, Trademark Examining Attorney, Law Office 117,  
Travis D. Wheatley, Managing Attorney.

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Before Wellington, Kuczma and Greenbaum,  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Lidl Stiftung & Co. KG (“Applicant”) seeks registration on the Principal Register



of the mark for: Sushi in International Class 30.<sup>1</sup> “SELECT” and

“TO GO” are disclaimed.


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<sup>1</sup> Application Serial No. 79171734 is a request for extension of protection of International Registration No. 1263075 pursuant to the Madrid Protocol, Trademark Act § 60 et. seq., 15 U.S.C. § 1141 et seq. The USPTO was notified of the request for extension on February 6, 2015. The mark consists of the wording “CHEF SELECT” in gray with two gray lines around

The Trademark Examining Attorney refused registration of Applicant's mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to a likelihood of confusion with the mark CHEF SELECT (standard character mark, "SELECT" disclaimed) in Registration No. 3873838 registered for "sushi" in International Class 30, owned by Fuji Food Products, Inc.<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration,<sup>3</sup> the appeal was resumed. We have considered the evidence and arguments presented by Applicant and the Examining Attorney. For the reasons set forth below, the refusal to register is affirmed.

#### I. Likelihood of Confusion

The sole issue to be decided is whether Applicant's mark  ("chef select to go & design") is confusingly similar to the mark CHEF SELECT in Registration No. 3873838 and should therefore be refused registration under § 2(d) of the Trademark Act.

Our determination of likelihood of confusion under § 2(d) is based on an analysis

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the wording "TO GO" in green, with a white arrow in the middle of the "O"; all other white in the drawing is not a feature of the mark and represents background. The colors gray and green are claimed as a feature of the mark.

<sup>2</sup> Registration No. 3873838 registered on November 9, 2010; §§8 and 15 declarations accepted.

<sup>3</sup> In the January 30, 2018 Request for Reconsideration Denied, the Examining Attorney withdrew the refusal under § 2(d) of the Trademark Act based on Registration No. 4156570.

of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We have considered all of the evidence as it pertains to the relevant *du Pont* factors, as well as Applicant's arguments (including any evidence and arguments not specifically discussed in this opinion). Here, the key considerations are the similarities between the marks, the identity of the goods, and the presumed similarity of the customers and trade channels of the goods. To the extent any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Goods, Channels of Trade, Classes of Customers

Applicant's goods are identical to Registrant's goods, i.e., sushi. When the goods are identical and their identifications have no restrictions as to nature, type, channels of trade, or classes of purchasers — as is the case here — the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *See In re Viterro Inc.*, 671 F. 3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983) (“absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”)).

Based on the identical goods set forth in the application and cited registration, and the overlapping trade channels and customers, the *du Pont* factors of the similarity of the goods, trade channels and customers strongly favor a finding of likelihood of confusion.

B. Similarity of the Marks

We turn next to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re Vittera*, 101 USPQ2d at 1908; *du Pont*, 177 USPQ at 567. We keep in mind that “[w]hen marks would appear on virtually identical goods . . ., as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Vittera*, 101 USPQ2d at 1908 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1740-41 (TTAB 2016).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Our analysis cannot be predicated on dissecting the marks into their various components; the marks must be viewed “in their entireties,” and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363,

116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

The record shows that the word “chef” is defined as “the chief . . . cook, especially in a restaurant or hotel . . .”, and “select” means “chosen in preference to another or others,” or “carefully chosen.”<sup>4</sup> Therefore, in connection with sushi, which is defined as “[a] Japanese dish consisting of small balls or rolls of vinegar-flavored cold cooked rice served with a garnish of raw fish, vegetables or egg,”<sup>5</sup> “chef select” means that the contents of the sushi dish were carefully or preferentially chosen by a cook or food preparer.

Looking at Applicant’s mark, because “chef” and “select” appear together in the same larger-sized font and color, connected with a gray line, the term “chef select”

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<sup>4</sup> See the dictionary definitions of “chef” in the March 15, 2016 Response to Office Action at TSDR 16, Dictionary.com, <<http://www.dictionary.com/browse/chef?s=t>>; and “select” in the September 11, 2015 Office Action at TSDR 72, COLLINS DICTIONARIES, <<http://www.collinsdictionary.com/dictionary/american/select>>, and March 15, 2016 Response to Office Action at TSDR 20 Dictionary.com, <<http://www.dictionary.com/browse/select?s=t>>.

Page references to the application record refer to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system.

<sup>5</sup> OXFORD DICTIONARIES (definition of sushi in US English) <<https://en.oxforddictionaries.com/definition/us/sushi>> attached as Exhibit 1 to Applicant’s Request for Reconsideration, TSDR 20.



appears as the dominant part of Applicant's mark.<sup>6</sup> Although it is improper to dissect a mark because marks must be viewed in their entirety, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Vittera*, 101 USPQ2d at 1908; *In re Nat'l Data*, 224 USPQ at 751; *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

Turning to the "to go" wording in Applicant's mark, the definition of "to go" submitted by the Examining Attorney is "1. (US) to be taken out (*said of food in a restaurant*)," which confirms that it is descriptive of Applicant's goods.<sup>7</sup> Applicant contends that even if "to go" is descriptive of its goods, it still adds a connotation to the commercial impression of the mark that is not found in the cited mark.

The merely descriptive term "to go," which Applicant disclaimed, is on the right-hand side of "chef select" in smaller font and presented in a different color.<sup>8</sup> The "to

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<sup>6</sup> Although Applicant and Registrant have disclaimed "select" in their respective marks, the filing of a disclaimer with the USPTO does not remove the disclaimed matter from the purview of determination of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (rejecting the "tactical strategy" of disclaimer filing in determination of likelihood of confusion).

<sup>7</sup> *See* the dictionary definition of "to go" in the September 11, 2015 Office Action at TSDR 75, COLLINS DICTIONARIES, <<http://www.collinsdictionary.com/dictionary/American/to-go>>, and online ads referring to "to go" menu categories such as "food-to-go" and "Grab & go." September 11, 2015 Office Action at TSDR 62-64 (<<http://www.mydemoulas.net/menus/markets-kitchen/>>), and TSDR 68-71 (<<http://www.timessupermarkets.com/taste-of-times-food-to-go-deli-and-kitchen/>>).

<sup>8</sup> The wording "to go" in Applicant's mark is distinguished from the "chef select" wording in the mark by being presented in a green color and in a smaller sized font than "chef select" which appears in a grey color. The colors gray and green are claimed as features of the mark. Applicant argues that the word element of its word-and-design mark could just as easily be

go” is additional wording that is commonly used to refer to prepared food products that can be taken out of a restaurant or food retailer to be consumed elsewhere. Moreover, in view of the descriptiveness of “to go” in Applicant’s mark, it would be likely that Registrant’s customers when seeing Applicant’s mark used in connection with sushi would believe that Registrant is offering its sushi “to go.” Therefore, in light of the descriptiveness of “to go” it does little, if anything, to differentiate Applicant’s mark from Registrant’s mark especially where both marks are for the identical food product.

Applicant’s mark incorporates Registrant’s mark in its entirety adding the descriptive terminology “to go.” Likelihood of confusion has frequently been found where the entirety of one mark, such as the cited mark, is incorporated within another, *i.e.*, Applicant’s mark. *See In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar); *In re El Torito Restaurants, Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBO likely to cause confusion with registered MACHO mark); *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY’S PIZZA for restaurant services specializing in pizza and PERRY’S for restaurant and bar services); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark in LE CACHET De DIOR does not avoid likelihood of confusion with registered CACHET mark). The fact that consumers are

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perceived as “chef to go select” as “chef select to go,” further distinguishing its applied-for mark from the cited mark. However, the color scheme, size and styling of the font used for the “to go” portion of Applicant’s mark distinguishes and differentiates it from the “chef select” portion of the mark.

generally more inclined to focus on the first words in any trademark, further supports the similarity of Applicant's and Registrant's marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that its applied-for mark is a stylized design mark which further distinguishes it from the cited mark given the highly suggestive nature of the shared term “chef select,” and the stylized “to go.”<sup>9</sup> The design element deserves less weight in our analysis because customers will use the wording of Applicant's mark, CHEF SELECT TO GO, in describing and requesting the goods. *In re Viterra*, 101 USPQ2d at 1908 (“In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed” (internal quotation marks omitted)); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999) (“In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods.”). Thus, the verbal portion of Applicant's mark is the dominant portion of the mark. *In re Viterra*, 101 USPQ2d at 1911 (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word

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<sup>9</sup> Applicant's Appeal Brief pp. 14-15 (12 TTABVUE 15-16). References to the briefs refer to the Board's TTABVUE docket system.

is normally accorded greater weight because it would be used by purchasers to request the goods or services”).

Applicant also argues that its mark:



includes a white arrow in the middle of the letter “o” in “go,” resembling a stylized version of a “play button,” itself a well-known cultural symbol connoting music, particularly digital music, thereby adding an additional connotation to its mark that is completely absent from the cited mark.<sup>10</sup> However, the white arrow in the middle of the “o” is of a relatively small size in comparison to the rest of the mark and therefore may not be noticed. Moreover, to the extent that the arrow is noted, and is associated with a play button, it would have no recognizable connotation with respect Applicant’s goods. Thus, this design does not impact the overall commercial impression of the mark.

The first part of Applicant’s mark is identical to Registrant’s standard character mark which may be displayed in any manner including in lower case gray font with the word “chef” above the word “select” as shown in Applicant’s mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color. *Citigroup Inc. v. Capital City Bank*

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<sup>10</sup> Applicant’s Appeal Brief p. 15 (12 TTABVue 16); Request for Reconsideration at TSDR 9, 17-18. Applicant’s application describes the wording “to go” as having “a white arrow in the middle of the ‘O’.”

*Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (registrant “entitled to depictions of the standard character mark regardless of font style, size, or color”); *see also In re Viterro*, 101 USPQ2d at 1909; *In re RSI Systems LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008). Thus, Applicant’s mark is identical in part to Registrant’s mark. While there is no explicit rule that we find marks to be similar where Applicant’s mark contains in part the whole of the mark in the cited registration, the fact that the cited registered mark is incorporated in full in Applicant’s mark increases the similarity between the two because the additional “to go” language in Applicant’s mark is a merely descriptive term that is a commonly used term in the food and restaurant industries. *See, e.g., In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009).

When comparing the marks the test is not whether they can be distinguished in a side-by-side comparison but rather whether they are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1721). Based upon the foregoing, Applicant’s and Registrant’s marks when considered in their entirety have a very similar commercial impression.

C. Number and Nature of Similar Marks in Use on Similar Goods

Under the sixth *du Pont* factor, the Board must consider evidence of “[t]he number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567. Applicant argues that the wording “chef select” found in both marks is highly suggestive and frequently used by numerous parties and therefore very weak as a trademark and thus, is only entitled to a very limited scope of protection.<sup>11</sup> In support, Applicant submits evidence of third-party use and registrations for marks containing the wording “chef select” or variations thereof.

“[E]vidence of third-party use of similar marks on similar goods ‘can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.’” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1674. Thus, evidence of widespread third-party use of similar marks with similar goods “is relevant to show that a mark is relatively weak and entitled only a narrow scope of protection” in that particular industry or field. *Palm Bay Imps. v. Veuve Clicquot*, 73 USPQ2d at 1693; *see also In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

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<sup>11</sup> Applicant’s Appeal Brief p. 12 (12 TTABVUE 13).

Applicant introduces thirty third-party uses on the Internet by restaurants using “chef select” in connection with menu items featuring sushi, and related food items<sup>12</sup> concluding that “[t]hese third party uses, appearing in both product designations and product descriptions, indicate widespread usage and understanding of ‘Chef Select’ as indicating that the contents of these sushi products of numerous parties have been carefully or preferentially selected by the preparer.”<sup>13</sup>

Looking more closely at those third-party uses, they show use of the terms “Chef’s select,” “chef’s select,” “Chef Select” and “chef select” in connection with sushi, nigiri<sup>14</sup>, fish platters, sushi rolls, veggie rolls, and sashimi, in product designation and product descriptions; rice and soy sauce, as well as use of “chef’s select the freshest fishes of

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<sup>12</sup> See April 14, 2017 Response to Letter of Suspension, Exhibit 1 (TSDR 44), January 8, 2018 Request for Reconsideration, Exhibit 2 (TSDR 21-48, 66), and April 2, 2018 Request for Suspension, Remand and Reconsideration, Exhibits 1 and 2 (7 TTABVUE 11-55), showing various uses of the terms “Chef’s select,” “chef’s select,” “Chef Select” and “chef select” in connection with sushi dishes offered by restaurants.

Applicant also submitted evidence showing use of “chef select,” “chef’s select,” and “chef’s selection,” in connection with other food products. See April 14, 2017 Response to Letter of Suspension, Exhibit 1 (TSDR 40, 45-88) for example in connection with cinnamon sticks; catfish and loins; Buffalo style chicken dip and chili pepper con queso; oil; lemons; mesclun; gourmet food store; meal plans; wedding buffet meal packages; restaurant menu items; desserts, and January 8, 2018 Request for Reconsideration, Exhibit 3 (TSDR 49-66) showing uses in connection with flavor blends; baby back pork ribs, pork tenderloin medallions and black angus eye round of beef menu items; Indian and Chinese cuisine menu items with seasonings; crab mac n’ cheese with spices and vegetables, and tenderloin with seasonings offered by a catering company.

<sup>13</sup> Applicant’s Appeal Brief pp. 7-11 (12 TTABVUE 8-12) citing to April 14, 2017 Response to Letter of Suspension, Exhibit 2 (TSDR 50-51, 61-62); January 8, 2018 Request for Reconsideration, Exhibit 2 (TSDR 21-48); and April 2, 2018 Request for Suspension, Remand and Reconsideration, Exhibits 1 and 2 (7 TTABVUE 11-55).

<sup>14</sup> Nigiri is “[a] type of sushi that consists of a lump of cooked, vinegar-seasoned rice rounded and pressed by hand into a loaflike shape and then topped with a thin slice of usually raw seafood, sometimes seasoned with wasabi and bound together by a strip of seaweed.” AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition published on The Free Dictionary by Farlex, Inc. at <https://www.thefreedictionary.com/nigiri>.

the day!” and “All of fish are chef’s select.” None of the restaurant advertisements or menus show “chef select” used as a trademark, i.e., identifying and distinguishing the menu items. Applicant contends that they show the “chef select” formatives used to indicate that the contents of the sushi-related products of the various restaurants have been “carefully or preferentially selected by the preparer.” Such uses of the various “chef select” terms by the restaurants are in the nature of advertising puffery, suggesting a desirable characteristic or quality of the menu items. *See In re Ralston Purina Co.*, 191 USPQ 237, 238 (TTAB 1976) (“SUPER” in “RALSTON SUPER SLUSH” (“slush” disclaimed) held suggestive of a “concentrate used to make a slush type soft drink” because word “is used as mere previous puffery ... to connote a vague desirable characteristic or quality”). Therefore, based on the evidence of record, “chef select” is highly suggestive of Applicant’s and Registrant’s sushi products.

Applicant also presents third-party registrations for marks it contends are similar to Registrant’s mark in support of its argument that Registrant’s mark is weak, diluted or so widely used that it is not entitled to a broad scope of protection.<sup>15</sup> There

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<sup>15</sup> See March 15, 2016 Response to Office Action and April 14, 2017 Response to Suspension Inquiry submitting copies of: Reg. No. 4282252 for CHEF SELECT (“select” disclaimed) for “beef” in Class 29; Reg. No. 3769435 for CHEFS SELECT (“select” disclaimed) for egg products in Class 29; Reg. No. 4156570 for CHEF’S SELECT (“select” disclaimed) for “spices and seasonings” in Class 30; and Reg. No. 2196641 for CHEF’S SELECTION (“selection” disclaimed) for “rice” in Class 30 together with a copy of on-line evidence showing use of the mark.

Several of the other registrations Applicant cites namely, Reg. No. 4542285 for J.T.M. CHEF’S SELECTIONS (“selections” disclaimed) for “cheese sauce with meat and cheese sauce with peppers;” Reg. No. 5050375 for OLIVARI CHEF’S SELECTION (“chef’s selection” disclaimed) for “edible oils for use in the commercial food service industry;” Reg. No. 4464017 for BUTTERBALL EVERY DAY CHEF SELECTS (“selects” disclaimed) for various food products including meats and poultry products, along with a copy of on-line evidence showing use of the mark; Reg. No. 4597905 for PREGEL 5-STAR CHEF PASTRY SELECT (“chef



are four registered marks, CHEF SELECT, CHEFS SELECT, CHEF'S SELECT and CHEF'S SELECTION, for food products or ingredients of products that could be served with sushi and are thus arguably related to sushi.<sup>16</sup> These four registrations, only one of which is for an identical mark to Registrant's mark, are consistent with

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pastry select" disclaimed) for flavorings, powders, fillings and pastes for use in making pastries, along with a copy of on-line evidence showing use of the mark; are for less similar food products and more importantly, are for marks which are very different from Applicant's mark beginning with a distinct first word followed by a variation of "chef select," i.e., CHEF'S SELECTIONS, CHEF'S SELECTION, CHEF SELECTS and CHEF PASTRY SELECT.

Lastly, Reg. Nos. 5139376 for QUORN CHEF'S SELECTION for numerous food products in Classes 29 and 30 including meat substitutes, egg substitutes, seasoning mixes for sauces, and cooking sauces; 4766292 for CHEF SELECT for food products in Classes 29 and 30 including sausage, poultry, game, processed vegetables, ready-to-serve and frozen meals, pasts, rice and ready-to-serve meals consisting primarily of rice or pasta [we note that Applicant is the owner of this Registration]; and 4228429 for LA SELECTION DU CHEF and Design for grain seeds, natural plants and flowers; live plants; seedlings in Class 31, are based on requests for extension of protection of international registrations granted under the Madrid Protocol under § 66(a) of the Trademark Act, 15 U.S.C. § 1141f, (additionally, for Reg. No. 4228429, a § 71 affidavit was due to be filed by October 23, 2018, or within a 6 month grace period ending on April 23, 2019. To date, a § 71 affidavit has not been filed). We consider only those marks which are registered and based on actual use. Marks that have been registered under the provisions of the Madrid Protocol for which no maintenance documents evincing use have been filed possess very little, if any, probative value because they do not require use in commerce to be registered and therefore are not evidence that the marks therein have ever been encountered by consumers in the marketplace, so as to expose consumers to a number of "Chef Select" formative terms as marks. *See In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988); *In re 1st USA Realty Profls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's March 15, 2016 Response to Office Action (Exhibit 3, TSDR 30) and April 14, 2017 Response to Suspension Inquiry (Exhibit 2, TSDR 18-19, 29, 36), also included evidence of Registrant's cited Reg. No. 3873838 for CHEF SELECT ("select" disclaimed) for sushi in Class 30; and Reg. No. 3905492 for CHEF SELECTS ("selects" disclaimed) for services including the preparation and serving of food in Class 43 which was cancelled on August 18, 2017 and therefore, was not considered.

<sup>16</sup> As listed in greater detail above, Reg. No. 4282252 for CHEF SELECT for "beef," Reg. No. 3769435 for CHEFS SELECT for egg products; Reg. No. 4156570 for CHEF'S SELECT for "spices and seasonings" and Reg. No. 2196641 for CHEF'S SELECTION for "rice."

the third-party evidence of use showing that CHEF SELECT is weak or diluted for sushi and related goods.

Applicant argues that when the evidence shows that a given mark is very weak with respect to a particular type of product, that mark has a limited scope of protection with respect to marks that add significant other matter to the weak term for use in connection with the identical type of product.<sup>17</sup> In support, Applicant cites five cases which found no likelihood of confusion where in addition to the two marks having a common element that was “proven weak through relevant third-party usage, one of the two marks contained matter that was **completely absent from and unlike anything in** the other mark, rendering the two marks not confusingly similar, **notwithstanding that the goods or services were identical and the additional matter in one of the marks was itself a suggestive or descriptive term and/or a design element.**”<sup>18</sup> (emphasis original). However, Applicant’s mark, unlike the marks involved in Applicant’s cited cases, begins with Registrant’s exact

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<sup>17</sup> Applicant’s Appeal Brief p. 13 (12 TTABVUE 14). “Where, as in the present case, the evidence shows that a given term is highly suggestive and frequently used by numerous parties with respect to a given type of product, and therefore very weak as a trademark for such goods, the mark is only entitled to a very limited scope of protection.” Applicant’s Appeal Brief p. 12 (12 TTABVUE 13).

<sup>18</sup> April 2, 2018 Request for Suspension and Remand to Examining Attorney pp. 5-6 (7 TTABVUE 6-7) and Applicant’s Appeal Brief p. 13 (12 TTABVUE 14) citing: *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015) (PEACE & LOVE for restaurant services and PEACE LOVE AND JUICE and Design for juice bar services), *Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014) (PERKS and PERKSPOT both for discount buying services), *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150 (TTAB 2012) (GRAND HOTEL and GRAND HOTELS NYC, both for hotel services), *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984) (KEY (stylized) and KEYCHECK, both for banking services), *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979) (PLUS and NATURE’S PLUS both for vitamins).


mark in its entirety followed by additional descriptive wording that does not distinguish its mark from Registrant's mark, especially when it is used on identical goods.

We are mindful that "extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established." *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (citing *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d at 1674-5). The third-party evidence of use and registrations introduced by Applicant shows that "Chef Select" has a highly suggestive meaning and therefore, the cited Registration is not entitled to a broad scope of protection. However, the scope of protection afforded to the cited mark, although weak, is sufficient to find Applicant's mark used on identical goods likely to be confused with the cited mark. Even weak marks are entitled to protection under § 2(d) against registration of Applicant's mark which is identical in part to Registrant's mark and used on identical goods. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982).

#### D. Conclusion

Having considered all of the evidence and arguments pertaining to the *du Pont* likelihood of confusion factors, including those portions we have not specifically cited, we find that Applicant's mark is likely to cause confusion with the cited mark. Applicant's goods are identical to the goods in the cited Registration, and in view of

the absence of any restrictions, are presumed to travel in the same trade channels as Registrant's goods. Although there are slight differences between Applicant's applied-

for mark  and Registrant's mark CHEF SELECT, the marks when considered in their entireties are highly similar in appearance, sound and meaning, creating a very similar overall commercial impression. Even considering the narrow scope of protection to which the term "chef select" is entitled, the additional words in Applicant's mark, i.e., "to go," are descriptive, and do not add a different connotation to Applicant's mark sufficient to distinguish it from the registered mark.

**Decision:** The refusal to register Applicant's mark  under § 2(d) of the Trademark Act is affirmed.